

Appln. No. 09/752,037
Amendment dated December 22, 2004
Reply to Office Action mailed September 22, 2004

REMARKS

Reconsideration is respectfully requested.

Claims 1 through 54 remain in this application. No claims have been cancelled. No claims have been withdrawn. No claims have been added in this Response.

Paragraphs 2 and 3 of the Office Action

Claims 1 through 3, 7, 9 through 14, 18, 20 through 29, 31 through 39, 41 and 44 through 54 have been rejected under 35 U.S.C. §102(b) as being anticipated by Novak (U.S. 4,266,098).

As previously noted, the claimed invention includes a system having a privacy mode that may be invoked by a user for a communication device. When invoked, the privacy mode requires the entry of a privacy mode code by the caller of the incoming call for the call to be completed.

In particular, claim 1 requires "determining if the communication device is in a privacy mode" and "if the communication device is in the privacy mode, completing the call if a privacy mode code is entered by the caller". The privacy mode feature of claim 1 permits the user to require a caller to the communication device to enter a privacy mode code in order for the call to be completed.

In the rejection set forth in the Office Action, it is contended that the requirement of "determining if the communication device is in a privacy mode" is disclosed by the Novak patent at col. 1, lines 50 through 56, which states (emphasis added):

In operation, incoming telephone calls 1 to answering telephone 3 are first intercepted by a telephone answering device 4 which, upon answering the call, would transfer incoming signals to an analog to decimal converter 5. As shown in FIG. 2, the answering device 4 could also, via message sender 9, convey an answering message to the caller to the effect that his call had been answered by an automatic device

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and invite the caller to transmit a predetermined code, but said message would not be essential to the operation of the invention.

This portion of the Novak patent indicates that the "answering telephone" "intercepts" all calls and sends the incoming calls to the telephone answering device of the Novak system, which answers all calls. The next sentence of this portion of Novak indicates that the "message sender" may send "an answering message" to the caller that asks the caller to transmit a predetermined code, but that *transmission of the message* is not essential. However, nothing here indicates that the Novak system has more than one "mode", and particularly nothing here indicates that the Novak has a privacy mode that, when invoked, completes a call if the caller enters a privacy mode code, as required by applicant's claim 1. In contrast, it appears from the discussion in the Novak patent that the telephone answering device answers all calls and requires the entry of a predetermined code from all callers at all times, without the system having any "mode" to be determined. In other words, the Novak system does not have any type of operation in which the caller does not have to enter the predetermined code that might be differentiated from its type of operation that requires the caller to enter (or attempt to enter) the predetermined code. This interpretation is confirmed further on in the Novak patent, where it is stated at col. 1, lines 65 through 68:

Upon having his call answered, the caller would transmit, via the answering device 4 to the analog to decimal converter 5 a predetermined code of one or more tones.

Again, this discussion indicates that the caller is required to transmit the predetermined code, and nothing suggest that there is any exception to this requirement. Further, it should be recognized that the different treatment of calls based upon the particular predetermined code transmitted by the caller *after the caller has been required to enter the predetermined code* does not amount to any privacy mode, since all callers are still required to enter the predetermined code regardless of how the Novak system may treat the calls

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after the code has successfully been entered. This similar treatment of all calls is also illustrated in Figure 2 of the drawings of Novak, where it can be seen that all calls follow the same path at least until the caller enters (or attempts to enter) the appropriate predetermined code.

It is therefore submitted that the Novak patent does not disclose or suggest to one of ordinary skill in the art any determination of whether a communication is in a privacy mode, since the Novak system does not have any manner of operation or mode other than its unalterable manner of handling calls by requiring the caller to enter a code regardless of any "mode" of the Novak device.

Additionally, independent claim 20 includes the requirements "determining if the communication device is in a privacy mode" and "if the communication device is in the privacy mode, completing the call if a predetermined code is entered by the caller" discussed above with respect to claim 1, and for the reasons set forth above with respect to claim 1, claim 20 is also submitted to be patentable over the Novak patent.

Claim 2 requires "if the communication device is in the privacy mode, routing the call to a message system if no privacy mode code is entered by the caller". As noted above, the caller to the Novak system is always required to enter the predetermined code, and thus there is no difference in the handling of the call because of the presence of a "privacy mode". The Novak system always directs the call to a message system if the wrong code is entered, without regard for any "privacy mode".

Claim 6 requires "receiving a request from the communication device to place the communication device *in the privacy mode*". Conversely, claim 8 requires "receiving a request from the communication device to place the communication device *out of the privacy mode*". As noted above, the Novak system has no provision for placing its telephone answering device in a

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"privacy mode" different from any other mode, since all incoming calls are required to enter the predetermined code and are thus all handled in the same manner at all times, and thus the Novak patent cannot teach one of ordinary skill in the art to move a communication device in and out of a privacy mode.

Independent claim 9, in addition to requiring "determining if the communication device is in a privacy mode", also requires "if the communication device is in the privacy mode, providing a privacy mode message *including a selected privacy override code to the caller*" (emphasis added). (Claim 22 includes similar requirements.) This feature of the invention allows the caller to be put on notice that the user of the communication device desires privacy, but also provides the caller with the means to override the privacy mode so that, in the case of an emergency, the caller is able to get the call completed to the communication device without prior knowledge of the privacy mode or override code.

Aside from the Novak system lacking any distinction between any modes of handling incoming calls, it is submitted that that the Miller patent would never lead one of ordinary skill in the art to "provid[e] a privacy mode message including a selected privacy override code to the caller", as this would render the Novak system completely useless for its intended purpose of preventing unwanted callers (who have not been specifically provided with a predetermined code by the user) from being able to stop those calls from being rung through. If the Novak system included a message that included the predetermined code, any caller would be able to circumvent the Novak system. One of ordinary skill in the art would not modify the Novak system in a manner that would render the Novak system ineffective for its primary intended purpose. Therefore, claim 9, as well as claims 10 through 19 which depend from claim 9, and claim 22, as well as claims 23 and 24 which depend from claim 22, are submitted to define over the Novak patent.

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Independent claim 25 requires "a data entry device capable of receiving input to cause the communication device to enter a privacy mode" and "a receiver capable of completing the call to the user if a privacy mode code is entered by the caller". It has been shown above that the user cannot affect the manner in which the Novak system handles incoming calls--all callers are required to enter a predetermined code--and thus there is no provision for "enter[ing a communication device into] a privacy mode". Therefore claim 25, as well as claims 26 through 30 which depend from claim 25, are submitted to not be anticipated by the Novak patent and are in condition for allowance.

Independent claim 31, similar in some respects to claim 9, requires "a data entry device capable of receiving input to cause the communication device to enter a privacy mode" and "a memory capable of providing a privacy mode message including a selected privacy override code to the caller prior to completing the call to the user". As noted above with respect to claim 9, the Novak document would never lead one of ordinary skill in the art to "providing a privacy mode message including a selected privacy override code to the caller prior to completing the call to the user", as this would render the Novak system utterly ineffective in blocking telemarketer calls. Claim 31, as well as claims 32 through 34 which depend from claim 32, are therefore submitted to be allowable over the Novak patent.

Independent claim 35 requires "a data entry device *capable of receiving input to cause the communication device to enter a privacy mode*" (emphasis added) and "a receiver capable of receiving the call to the communication device and completing the call to the user only if an interrupt is received from the caller". As noted on several occasions above, the Novak system lacks any ability to change the way in which incoming calls are handled, and thus there is no privacy mode to enter from any other mode. Thus, it is submitted that the Novak patent does not anticipate the

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requirements of claim 35, and therefore claim 35, as well as claim 36 which depends from claim 35, are submitted to be in condition for allowance.

Independent claim 37 requires "a memory capable of storing a status indicating if the communication device is in a privacy mode" and "a transmitter capable of completing the call to the user if the communication device is in the privacy mode and the privacy mode code is entered by the caller". In addition to the Novak system lacking any mode that is different from its single manner of operation, the Novak system lacks any manner for storing a status indicating that the Novak system is in such a privacy mode. As noted previously, the user of the Novak system is incapable of changing the requirement that the incoming callers enter the predetermined code, so storing a status of a mode of handling calls is not implied.

Claim 51 requires that "if the communication device is in the privacy mode, announcing the privacy mode code to the caller", and claim 52 requires that "the step of providing a privacy mode message includ[e] a selected privacy override code to the caller further comprises announcing the privacy code to the caller". This requirement is contrary to the Novak system, as the Novak patent clearly states that one of its objects is to mask the function of the Novak system from the caller. See, e.g., Novak at col. 1, lines 29 through 36 (emphasis added):

Another object of the invention is for the device to operate without divulging to the caller why his call was not answered. It would thus prevent burglars from correctly assuming that an unanswered call indicated that the called party was not at home. Conversely, it would allow a user to not answer a call without offending a caller, as that caller would have no way of knowing that the user was, in fact, at home.

Clearly, "announcing the privacy mode code to the caller" is anathema to the objects of the Novak patent, as the caller would clearly realize that his or her call was subject to screening by the privacy mode if it were announced.

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Claim 53 requires "the step of receiving a spoken command from a user of the communication device to place the communication device in the privacy mode", and as the manner in which the Novak system handles incoming calls cannot be altered, it is submitted that this feature is foreign to the Novak system.

Claim 54 requires that "if the communication device is in the privacy mode, preventing the communication device from producing an incoming call signal if the privacy mode code is not entered by the caller while providing information regarding the incoming call through a display on the communication device". Again, the Novak patent does not provide for any variation from the single manner of operation that requires all callers to enter a predetermined code, and thus it is submitted that Novak cannot anticipate this requirement.

Withdrawal of the §102(b) rejection of claims 1 through 3, 7, 9 through 14, 18, 20 through 29, 31 through 39, 41 and 44 through 54 is therefore respectfully requested.

Paragraphs 4 and 5 of the Office Action

Claims 4 through 6, 8, 15 through 17, 19, 30, 40 and 42 through 43 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Novak (U.S. 4,266,098) in view of Patsiokas et al (U.S. 4,941,203).

It is submitted that the disclosure of the Patsiokas patent does not make up for the shortcomings of the Novak patent in anticipating the requirements of the claimed invention, particularly the lack of a privacy mode that may be placed on or removed from a communication device.

In particular, the Patsiokas et al. patent states at col. 3, lines 35 through 44 (emphasis added) that:

For emergency calls, each remote unit operator may provide

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selected individuals with a pre-programmed "Override Code." Thus, if a call originator is informed that a particular remote unit is in the Message Storage mode, and the call originator enters the appropriate Override Code through the call originator's telephone or remote unit keypad, voice communications will be established between the call originator and the called remote unit, despite the fact that the remote unit is currently in the Message Storage mode.

In light of this statement in the Patsiokas patent that the operator of the remote unit *may* provide "selected" people with an "override code", it is clear that since only some people have the "override code", the "override code" is not a part of any message that is played for the call originator, and thus does not teach a "privacy mode message *including* a selected privacy override code" as required by claims 9, 22, and 31. Nor does Patsiokas teach that "if the communication device is in the privacy mode, *announcing* the privacy mode code to the caller" as required by claim 51 or "*announcing* the privacy mode code to the caller" as required by claim 52.

Further, with respect to the Patsiokas patent, it is noted that Patsiokas states that the "override code" is "pre-programmed", which leads one of ordinary skill in the art to believe that the "override code" is not "selected by a user of the communication device", as required by claims 3, 7, 14, 18, 29, 34, 41, but is instead more likely outside of the control of the user.

Withdrawal of the §103(a) rejection of claims 4 through 6, 8, 15 through 17, 19, 30, 40 and 42 through 43 is therefore respectfully requested.


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CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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